

II. REMARKS

A. General Remarks

Claims 1-50 were pending prior to this submission. Claims 1-16 are cancelled and are being pursued in a co-pending divisional application. New claims 51-60 have been added. Therefore, claims 17-60 are pending.

For the convenience of the Examiner, Applicants have reprinted portions of the Final Office Action in 10-point type, bolded and italicized. Applicants' statements or arguments immediately follow each section.

B. Claim Rejections - 35 U.S.C. § 103

1. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. *Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Critelli et al. alone.*

With regard to claim 17, Critelli discloses a method for distributing a plurality of items to a customer (see abstract) that includes the steps of placing the items in a shipping unit (11, Fig. 1, col. 2 line 50+), placing a label (18, Fig. 2) having a unique identifier on the shipping unit (col. 2 line 61 +, col. 3 line 1+), creating a shipment record identifying the unit by the identifier and listing the items within the unit wherein the record associates the identifier with the items in the shipping unit (col. 3 line 28+, col. 4 line 27+, col. 5 line 1+, common practice), sending and delivering the shipping unit and shipment record to the customer (abstract, col. 4 line 49+, col. 5 line 1+), receiving the shipping unit by the customer, and identifying the shipping unit by the customer by electronically reading the identifier on the label (col. 4 line 50+, col. 5 line 1+). With regard to claim 18, the contents of the shipping unit are verified using the listing of items on the shipping record (col. 5 line 2+, abstract). With regard to claim 19, it is not explicitly stated that discrepancies between the shipping unit contents and the shipping, record are electronically recorded, however, in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+) and some record would be made of this, electronic or otherwise, as this is common practice. With regard to claims 20 and 21, delivery and receipt records are created by electronically reading the identifier (col. 4 line 49+, col. 5 line 1+). It is not explicitly stated that discrepancies between the shipping unit contents and the shipping record are recorded, however, in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+) and some record would be made of this. With regard to claim 22, the identifier is a barcode (col. 2 line 60). With regard to claim 23, the shipment record is stored on a personal computer (col. 4 line 1+, see Fig. 5). With regard to claims 24 and 25, the customer's signature and the time of delivery are electronically captured (col. 5 line 1+).

Applicants do not acquiesce that the *Critelli et al.* reference is a proper prior art reference, in light of the Provisional application upon which this pending application claims priority and in light of Applicants' developmental efforts of the claimed invention. However, even if *Critelli et al.* were a proper prior art reference, Applicants respectfully traverse the Examiner's conclusion that *Critelli et al.* renders the listed claims obvious as follows.

1. Claims 17-25 and 27-38 Are Not Rendered Obvious Over *Critelli et al.*

Applicants respectfully traverse the Examiner's conclusion that *Critelli et al.* renders the listed claims obvious. In the rejection of claims 17-25 and 27-38, the Examiner contends that *Critelli et al.* allegedly discloses limitations of claims 17-25 and 27-38 and that *Critelli et al.* can be modified by common practices to render the listed claims obvious. Applicants respectfully disagree with the Examiner's characterization of *Critelli et al.* and respectfully disagree that *Critelli et al.* renders claims 17-25 and 27-38 obvious.

a) Claims 17-25 and 27-38 Must Be Considered As A Whole

Applicants contend that the Final Office Action has rejected claims 17-25 and 27-38 as obvious over *Critelli et al.* without considering the claims as a whole. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)).

In the rejection, the Examiner has characterized *Critelli et al.* and alleges that *Critelli et al.* discloses limitations of the listed claims. Applicants respectfully disagree with the Examiner's characterization of *Critelli et al.* and contends that *Critelli et al.* falls short of

disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, Applicants wish to point out the claimed invention as a whole compared to the disclosure of *Critelli et al.*

Claim 17 is directed to a method of distributing a plurality of items to a customer. Items destined for the customer are placed into a shipping unit, and a label having a unique identifier is placed on said shipping unit. An electronic shipment record is created that identifies the shipping unit by the identifier and listing the items within the shipping unit. The shipment record associates the identifier with the items within the shipping unit. The electronic shipment record is sent to the customer, and the shipping unit is delivered to the customer. The customer receives the shipping unit by identifying the shipping unit using the electronic shipment record sent to the customer, where identifying is done by electronically reading the identifier on the label of the container.

In stark contrast to claim 17, *Critelli et al.* discloses placing a frangible electronic circuit (19) in the material to be contained within a container (11) and attaching indicia (18) on the container (11). *See Critelli et al.* at col. 2, line 61+; col. 3, line 10+. The container is then delivered to the customer. Once the container is delivered, the information transmitted by the circuit (19) and the information appearing on container (11) are read by the carrier and a delivery receipt is merely printed. *See Critelli et al.* at col. 4, line 25+. The customer is simply presented with the delivery receipt and is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67” *Critelli et al.* at col. 5, ll. 3-5. The customer in *Critelli et al.* does not receive an electronic shipment record that is used by the customer when receiving the container. Thus, the customer in *Critelli et al.* does not identify the container and associated items using the electronic shipment record sent to the customer. Nor

does the customer in *Critelli et al.* identify the container by electronically reading the identifier on the label.

Despite the disparity between claim 17 and the disclosure of *Critelli et al.*, the rejection states that *Critelli et al.* discloses “creating a shipment record identifying the unit by the identifier and listing the items within the unit wherein the record associates the identifier with the items in the shipping unit (col. 3 line 28+, col. 4 line 27+, col. 5 line 1+, common practice), sending and delivering the shipping unit and shipment record to the customer (abstract, col. 4 line 49+, col. 5 line 1+).” Applicants respectfully disagree with the Examiner’s characterization of *Critelli et al.* When claim 17 is viewed as a whole, *Critelli et al.* at least does not teach or suggest creating an electronic shipment record that associates an identifier on the container with the items within the container and that is sent to the customer, as required in claim 17. Instead, *Critelli et al.* merely discloses separately placing information on the item and on the container for the item. In *Critelli et al.*, a shipment record associating the item and container together is not made and such a record is not sent to the customer before delivering the container to the customer. Rather, the information on the item and on the container are simply read together at the time of delivery to print a delivery receipt for the customer. Thus, *Critelli et al.* falls short of teaching or suggesting all the limitations of independent claim 17.

Despite the disparity between claim 17 and the disclosure of *Critelli et al.*, the rejection also states that *Critelli et al.* discloses “receiving the shipping unit by the customer, and identifying the shipping unit by the customer by electronically reading the identifier on the label (col. 4 line 50+, col. 5 line 1+).” Applicants respectfully disagree with the Examiner’s characterization of *Critelli et al.* When claim 17 is viewed as a whole, *Critelli et al.* at least does not teach or suggest that the customer, after receiving an electronic shipment record associating

the items and container, receives the container by identifying the container and associated items using the electronic shipment record, where identifying by electronically reading the identifier on the container. Instead, *Critelli et al.* merely discloses that the courier scans the indicia (18) and receives information from the frangible circuit (19) to produce a delivery receipt. See *Critelli et al.* at col. 4, ll. 49-65. The customer is simply presented with the delivery receipt identifying the information on the container and the information on the item in the container and is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67” *Critelli et al.* at col. 5, ll. 3-5. Thus, *Critelli et al.* falls short of teaching or suggesting all the limitations of independent claim 17.

Despite the disparity between claims 17 and the disclosure of *Critelli et al.*, the rejection further states that *Critelli et al.* discloses limitations of claims depending from claim 17. Applicants respectfully disagree with the Examiner’s characterization of *Critelli et al.* when claims 17-25 and 27-38 are viewed as a whole. In claim 18, for example, the customer receives the shipping unit by verifying contents of the shipping unit using the listing of the items within the container in the electronic shipment record. In claim 19, for example, the customer receives the shipping unit by electronically recording any discrepancy between the contents of the shipping unit and the listing in the electronic shipment record. In claim 21, for example, the customer receives the shipping unit by creating a receipt record of the receipt of the shipping unit, the receipt record created by identifying the shipping unit and listing any differences between the items listed on the electronic shipment record and the items within the container.

By contrast, *Critelli et al.* merely discloses that the customer is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67” at the time of delivery. *Critelli et al.* at col. 5, ll. 3-5. Thus, not only does *Critelli et al.*

not teach or suggest all the elements of independent claim 17, but also *Critelli et al.* does not teach or suggest all the limitations of claims that depend therefrom.

b) Reliance on Common Practice

The rejection of the listed claims contends that *Critelli et al.* can be apparently modified by common practices to render the listed claims obvious. One limitation of claim 17 that can be allegedly modified by common practice includes “creating a shipment record identifying the unit by the identifier and listing the items within the unit wherein the record associates the identifier with the items in the shipping unit (col. 3 line 28+, col. 4 line 27+, col. 5 line 1+, common practice).” Claim 19 can be allegedly modified by common practice because “in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+) and some record would be made of this, electronic or otherwise, as this is common practice.” Also, claim 21 can be allegedly modified by common practice because “in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+) and some record would be made of this.”

Applicants have disagreed with the Examiner’s characterization of *Critelli et al.* In the discussion presented above, *Critelli et al.* falls short of disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, despite the rejections reliance on common practice, these alleged common practices, which Applicants do not concede offer proper motivation to modify *Critelli et al.*, do not correct the deficiencies missing from the disclosure of *Critelli et al.* In addition, Applicants respectfully traverse the Examiner’s assertions that the Examiner’s characterization of *Critelli et al.* can be modified by common practice to render the listed claims obvious. Accordingly, the Examiner should withdraw the position in the next paper from the Office, or cite a reference in support of the position. See M.P.E.P. § 2144.03.

c) *Critelli et al.* Does Not Render Claims 17-25 and 27-38 Obvious

As evidenced by the above discussion, Applicants respectfully disagree with the Examiner's characterization of *Critelli et al.*, because the disclosure of *Critelli et al.* falls well short of disclosing all of the limitations of claims 17-25 and 27-38 when viewed as a whole. As also evidenced by the above discussion, Applicants respectfully traverse the assertion that the Examiner's characterization of *Critelli et al.* can be modified by common practice to render the listed claims obvious, because the alleged common practices, which Applicants do not concede offer proper motivation to modify *Critelli et al.*, do not correct the deficiencies missing from the disclosure of *Critelli et al.* Therefore, *Critelli et al.* does not render the listed claims obvious. For at least these reasons, Applicants respectfully request reconsideration and withdraw of the rejection and respectfully request allowance of claims 17-25 and 27-38 in the next paper from the Office.

Amendments have been made to claims 17, which includes the recitation of "wherein the customer receives the shipping unit," to improve the reading of the claim. Amendments have been made to claims 18-21, which include the recitation "wherein receiving said shipping unit by said customer," to improve the reading of the claims. Claims 17-19, 21, and 31-34 have been amended to recite an "electronic" shipment record. Other purely cosmetic amendments have been made throughout the claims. The above amendments are fully supported by the originally filed disclosure and do not add new matter.

2. Claims 26 and 39-40 Are Not Rendered Obvious Over *Critelli et al.*

3. *Claims 26-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Critelli et al. alone.*

Critelli discloses a method for distributing a plurality of items from a storage location to a remote site (see abstract) that includes the steps of creating an electronic shipment record listing the items to be delivered (col. 3 line 28+, col. 4 line 27+), delivering the items to the remote site (abstract, col. 4 line 49+), sending and delivering the shipping unit and shipment record to the remote site (abstract, col. 4 line 49+, col. 5 line 1+), and creating an electronic delivery record of the items delivered (col. 4 line 49+, col. 5 line 1+). It is not explicitly

stated that the quantity of each of the items is listed or that discrepancies between the shipped and delivered quantities are recorded, however, it would be obvious to one skilled in the art that a variety of information could be included on the shipment and delivery records, including quantity and discrepancy information. Furthermore, in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+), and some record would be made of this, as this is common practice. The identifier can be used to determine the location of the shipping unit (col. 5 line 1+), delivery information is transmitted between a distribution center computer and a delivery device which could be used for a variety of purposes, like tracking (col. 5 line 20+, common practice), creating a delivery record after delivering the unit, contents of the unit are verified by reading the identifier and looking at shipment record (col. 5 line 1+, common practice), the contents of the shipping unit are verified using the listing of items on the shipping record (col. 5 line 2+, abstract). It is not explicitly stated that discrepancies between the shipping unit contents and the shipping record are electronically recorded, however, in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+). It would be obvious to one skilled in the art that the items in the shipping unit could be verified at any point by using a variety of different information.

Applicants do not acquiesce that the *Critelli et al.* reference is a proper prior art reference as stated above; however, even if it were, Applicants respectfully traverse the Examiner's conclusion that *Critelli et al.* renders the listed claims obvious. In the rejection of claims 26 and 39-40, the Examiner contends that *Critelli et al.* allegedly discloses all limitations of claims 26 and 39-40 and that *Critelli et al.* can be modified by common practices to render the listed claims obvious. Applicants respectfully disagree with the Examiner's characterization of *Critelli et al.* and respectfully disagree that *Critelli et al.* renders claims 26 and 39-40 obvious.

a) Claims 26 and 39-40 Must Be Considered As A Whole

Applicants contend that the Final Office has rejected claims 26 and 39-40 as obvious over *Critelli et al.* without considering the claims as a whole. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)).

In the rejection, the Examiner has characterized *Critelli et al.* and alleges that *Critelli et al.* discloses limitations of the listed claims. Applicants respectfully disagree with the

Examiner's characterization of *Critelli et al.* and contends that *Critelli et al.* falls short of disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, Applicants wish to point out the claimed invention as a whole compared to the disclosure of *Critelli et al.*

Claim 26 is directed to a method of distributing a plurality of items from a warehouse to a remote site. An electronic shipment record is created of the items to be delivered to the remote site where the shipment record lists a shipping quantity of each of the items. The electronic shipment record is sent to the remote site, and the items are delivered at the remote site. The remote site receives the shipping unit by creating an electronic delivery record, using the electronic shipment record, of the items delivered at the remote site. The delivery record lists a delivered quantity of each of the items and identifies any differences between the shipping quantity and the delivered quantity.

In stark contrast, *Critelli et al.* discloses placing a frangible electronic circuit (19) in the material to be contained within a container (11) and attaching indicia (18) on the container (11). The container is then delivered to the customer. Once the container is delivered, the information transmitted by the circuit (19) and the information appearing on container (11) are read by the deliverer and a delivery receipt is merely printed. The customer is simply presented with the delivery receipt at the time of delivery and is merely "asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67." *Critelli et al.* at col. 5, ll. 3-5. The customer in *Critelli et al.* does not receive an electronic shipment record that is used by the customer when receiving the container. Thus, the customer in *Critelli et al.* does not identify the container and associated items using the electronic shipment record sent to the customer. Nor does the customer in *Critelli et al.* identify the container by electronically

reading the identifier on the label.

Therefore, *Critelli et al.* at least does not teach or suggest creating an electronic shipment record of items to be delivered to the remote site where the shipment record lists a shipping quantity of each of the items and sending the electronic shipment record to the remote site, as required in claim 26. Instead, *Critelli et al.* merely discloses separately placing information on the item and on the container for the item. In *Critelli et al.*, a shipment record listing a shipping quantity of each of the items is not made and such a record is not sent to the remote site before delivering the items to the remote site. Rather, the information of the item is simply read at the time of delivery to print a delivery receipt for the customer. Thus, *Critelli et al.* falls short of teaching or suggesting all the limitations of independent claim 26.

In addition, *Critelli et al.* at least does not teach or suggest that the remote site, after receiving an electronic shipment record having the list of items, receives the items by creating an electronic delivery record, using said electronic shipment record, of said items delivered at said remote site, said delivery record listing a delivered quantity of each of said items and identifying any differences between said shipping quantity and said delivered quantity. Instead, *Critelli et al.* merely discloses that the customer is presented with a delivery receipt identifying the information on the item in the container at the time of delivery and is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67.” *Critelli et al.* at col. 5, ll. 3-5. Thus, *Critelli et al.* falls short of teaching or suggesting all the limitations of independent claim 26. Furthermore, *Critelli et al.* does not teach or suggest limitations of claims 39-40 that depend from claim 26.

b) Reliance on Common Practice

The rejection of the listed claims contends that *Critelli et al.* can be apparently modified by common practices to render the listed claims obvious. Applicants have disagreed with the

Examiner's characterization of *Critelli et al.* In the discussion presented above, *Critelli et al.* falls short of disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, despite the rejections reliance on common practice, these alleged common practices, which Applicants' do not conceded offer proper motivation to modify *Critelli et al.*, do not correct the deficiencies missing from the disclosure of *Critelli et al.* In addition, Applicants respectfully traverse the Examiner's assertions that the Examiner's characterization of *Critelli et al.* can be modified by common practice to render the listed claims obvious. Accordingly, the Examiner should withdraw the position in the next paper from the Office, or cite a reference in support of the position. See M.P.E.P. § 2144.03.

c) *Critelli et al.* Does Not Render Claims 26 and 39-40 Obvious

As evidenced by the above discussion, Applicants respectfully disagree with the Examiner's characterization of *Critelli et al.*, because the disclosure of *Critelli et al.* falls well short of disclosing all of the limitations of claims 26 and 39-40 when viewed as a whole. As also evidenced by the above discussion, Applicants respectfully traverse the assertion that the Examiner's characterization of *Critelli et al.* can be modified by common practice to render the listed claims obvious, because the alleged common practices, which Applicants do not concede offer proper motivation to modify *Critelli et al.*, do not correct the deficiencies missing from the disclosure of *Critelli et al.* Therefore, *Critelli et al.* does not render the listed claims obvious. For at least these reasons, Applicants respectfully request reconsideration and withdraw of the rejection and respectfully request allowance of claims 26 and 39-40 in the next paper from the Office.

Amendments have been made to claims 26, which include the recitation of "wherein said remote site receives said shipping unit" to improve the reading of the claims. Claim 26 has been amended to recite an "electronic" shipmen record as recited elsewhere in the claim. Other purely

cosmetic amendments have been made. The above amendments are fully supported by the originally filed disclosure and do not add new matter.

3. Claims 41-50 Are Not Rendered Obvious Over *Critelli et al.*

4. *Claims 41-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Critelli et al. alone.*

Critelli discloses a method for distributing a plurality of items to a customer (see abstract) that includes the steps of submitting an order for items by the customer, placing the items in a shipping unit (11, Fig. 1, col. 2 line 50+), placing a label (18, Fig. 2) having a unique identifier on the shipping unit (col. 2 line 61 +, col. 3 line 1+), creating a shipment record identifying the unit by the identifier and listing the items within the unit wherein the record associates the identifier with the items in the shipping unit (col. 3 line 28+, col. 4 line 27+, col. 5 line 1+, common practice), sending and delivering the shipping unit and shipment record to the customer (abstract, col. 4 line 49+, col. 5 line 1+), receiving the shipping unit by the customer, identifying the shipping unit by the customer by electronically reading the identifier on the label (col. 4 line 50+, col. 5 line 1+), and reconciling the items received with the items on the shipment record (col. 5 line 4+). It is not explicitly stated that discrepancies between the shipping unit contents and the shipping record are electronically recorded or that a warning signal is generated, however, in the case of discrepancies the customer would not agree to the information on the shipping record (col. 5 line 4+) and some record would be made of this, electronic or otherwise, as this is common practice. Delivery and receipt records are created by electronically reading the identifier (a barcode, see Fig. 2) and could include a variety of information, like deliver time (col. 4 line 49+, col. 5 line 1+). It is common practice to scan items at various points in the supply/delivery chain (ordering, returns, etc.) and to include appropriate information regarding the item (location, quantity, status) and to transfer this information to a central system.

Applicants do not acquiesce that the *Critelli et al.* reference is a proper prior art reference; however, even if it were, Applicants respectfully traverse the Examiner's conclusion that *Critelli et al.* renders the listed claims obvious. In the rejection of claims 41-50, the Examiner contends that *Critelli et al.* allegedly discloses all limitations of claims 41-50 and that *Critelli et al.* can be modified by common practices to render the listed claims obvious. Applicants respectfully disagree with the Examiner's characterization of *Critelli et al.* and respectfully disagree that *Critelli et al.* renders claims 41-50 obvious.

a) Claims 41-50 Must Be Considered As A Whole

Applicants contend that the Final Office has rejected claims 41-50 as obvious over *Critelli et al.* without considering the claims as a whole. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

would have been obvious.” M.P.E.P. § 2141.02 (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530,218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)).

In the rejection, the Examiner has characterized *Critelli et al.* and alleges that *Critelli et al.* discloses limitations of the listed claims. Applicants respectfully disagree with the Examiner’s characterization of *Critelli et al.* and contends that *Critelli et al.* falls short of disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, Applicants wish to point out the claimed invention as a whole compared to the disclosure of *Critelli et al.*

Claim 41 is directed to a method for distributing a plurality of items to a customer. An order is submitted to a distribution center by the customer for the items to be delivered. The ordered items are placed into a container with each item having an item identifier to uniquely identify each item. A label is placed on the container, where the label has a unique container identifier. The container is delivered to the customer, and shipment and invoice data containing the items shipped and ordered is sent to the customer. The customer receives the container. The method includes identifying the delivered container and the items in the container by using the shipment and invoice data by the customer electronically reading the container identifier on the label of the container. The method includes determining the items received by identifying the items in the container by electronically reading the item identifier on each item. Finally, the method includes reconciling the items received with the items on the shipment and invoice data.

In stark contrast to claim 41, *Critelli et al.* discloses placing a frangible electronic circuit (19) in the material to be contained within a container (11) and attaching indicia (18) on the container (11). The container is then delivered to the customer. Once the container is delivered,

the information transmitted by the circuit (19) and the information appearing on container (11) are read by the deliverer and a delivery receipt is merely printed. The customer is simply presented with the delivery receipt at the time of delivery and is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67.” *Critelli et al.* at col. 5, ll. 3-5. The customer in *Critelli et al.* does not receive an electronic shipment record that is used by the customer when receiving the container. Thus, the customer in *Critelli et al.* does not identify the container and associated items using the electronic shipment record sent to the customer. Nor does the customer in *Critelli et al.* identify the container by electronically reading the identifier on the label.

Therefore, *Critelli et al.* at least does not teach or suggest creating an electronic shipment record of items to be delivered to the remote site where the shipment record lists a shipping quantity of each of the items and sending the electronic shipment record to the remote site, as required in claim 41. Instead, *Critelli et al.* merely discloses separately placing information on the item and on the container for the item. In *Critelli et al.*, a shipment record listing a shipping quantity of each of the items is not made and such a record is not sent to the remote site before delivering the items to the remote site. Rather, the information of the item is simply read at the time of delivery to print a delivery receipt for the customer. Thus, *Critelli et al.* falls short of teaching or suggesting all the limitations of independent claim 41.

In addition, *Critelli et al.* at least does not teach or suggest that the remote site, after receiving an electronic shipment record having the list of items, receives the items by creating an electronic delivery record, using said electronic shipment record, of said items delivered at said remote site, said delivery record listing a delivered quantity of each of said items and identifying any differences between said shipping quantity and said delivered quantity. Instead, *Critelli et*

al. merely discloses that the customer is presented with a delivery receipt identifying the information on the item in the container at the time of delivery and is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67.” *Critelli et al.* at col. 5, ll. 3-5. Thus, *Critelli et al.* falls short of teaching or suggesting all the limitations of independent claim 41. Furthermore, *Critelli et al.* does not teach or suggest limitations of claims 42-50 that depend from claim 41.

b) Reliance on Common Practice

The rejection of the listed claims contends that *Critelli et al.* can be apparently modified by common practices to render the listed claims obvious. Applicants have disagreed with the Examiner’s characterization of *Critelli et al.* In the discussion presented above, *Critelli et al.* falls short of disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, despite the rejections reliance on common practice, these alleged common practices, which Applicants’ do not conceded offer proper motivation to modify *Critelli et al.*, do not correct the deficiencies missing from the disclosure of *Critelli et al.* In addition, Applicants respectfully traverse the Examiner’s assertions that the Examiner’s characterization of *Critelli et al.* can be modified by common practice to render the listed claims obvious. Accordingly, the Examiner should cite a reference in support of the position or withdraw the position in the next paper from the Office. See M.P.E.P. § 2144.03.

c) *Critelli et al.* Does Not Render Claims 41-50 Obvious

As evidenced by the above discussion, Applicants respectfully disagree with the Examiner’s characterization of *Critelli et al.*, because the disclosure of *Critelli et al.* falls well short of disclosing all of the limitations of claims 41-50 when viewed as a whole. As also evidenced by the above discussion, Applicants respectfully traverse the assertion that the Examiner’s characterization of *Critelli et al.* can be modified by common practice to render the

listed claims obvious, because the alleged common practices, which Applicants do not concede offer proper motivation to modify *Critelli et al.*, do not correct the deficiencies missing from the disclosure of *Critelli et al.* Therefore, *Critelli et al.* does not render the listed claims obvious. For at least these reasons, Applicants respectfully request reconsideration and withdraw of the rejection and respectfully request allowance of claims 41-50 in the next paper from the Office.

C. New Claims 51-60 Are Not Anticipated By Nor Rendered Obvious Over the Art of Record

Applicants have added new claims 51-60. New claims 51-60 are fully supported by the originally filed disclosure, and no new matter has been added to the specification. Specific support for new claims 51-60 can at least be found at Figures 2-6, 16-23, 25-43 and corresponding portions of the written description. New independent claim 51 recites:

51. (New) A method of distributing a plurality of items from a distributor to a customer, the distributor having a distribution database, the customer having a customer database, the items having item identifiers and being shipped in a container having a container identifier, the method comprising the steps of:
- a) creating an electronic invoice in the distribution database by electronically associating the item identifiers on the items with the container identifier on the container in which the items are packed;
 - b) sending the electronic invoice from the distribution database to the customer database; and
 - c) creating an electronic receipt in the customer database when receiving the container delivered to the customer with the packed items by electronically reconciling the items packed in the delivered container with the items on the electronic invoice in the customer database.

In new claim 51, an electronic invoice is created in a distribution database by electronically associating the item identifiers on the items with the container identifier on the container in which the items are packed. The electronic invoice is then sent from the distribution database to the customer database. An electronic receipt is created in the customer database when receiving the container delivered to the customer with the packed items by electronically

reconciling the items packed in the delivered container with the items on the electronic invoice in the customer database.

In contrast to new claim 51 and as noted previously, *Critelli et al.* (assuming without acquiescing that it is prior art) at least does not teach or suggest creating an electronic invoice in a distribution database that electronically associates the item identifiers on the items with the container identifier on the container and that is sent to the customer before delivery, as required by claim 51. Instead, *Critelli et al.* merely discloses separately placing information on the item and on the container for the item. In *Critelli et al.*, a shipment record listing a shipping quantity of each of the items is not made and such a record is not sent to the customer before delivering the items to the remote site. Rather, the information of the item is simply read at the time of delivery to print a delivery receipt for the customer.

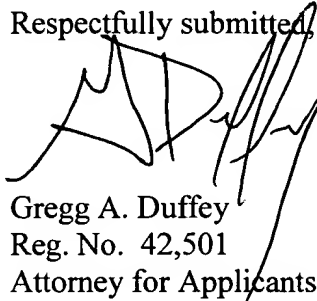
In addition, *Critelli et al.* does not teach or suggest the limitation that the customer, after receiving an electronic invoice having the items, creates an electronic receipt in the customer database by electronically reconciling the items packed in the delivered container with the items on the electronic invoice in the customer database. Instead, *Critelli et al.* merely discloses that the customer is presented with a delivery receipt identifying the information on the item in the container and is merely “asked to confirm that the information appearing on the receipt 71 is the same as the information displayed by tablet 67” *Critelli et al.* at col. 5, ll. 3-5.

The other prior art references of record fail to disclose, teach or suggest the limitation of newly added claims 51-60.

D. Conclusion

The Examiner is invited to contact the undersigned attorney at 713.787.1400 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,



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